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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,046	03/05/2002	Peng Chen	P6340 (301101-000009)	6492
28465	7590	05/12/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US LLP			SUBRAMANIAN, NARAYANSWAMY	
P. O. BOX 64807			ART UNIT	
CHICAGO, IL 60664-0807			PAPER NUMBER	

3624

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,046

Applicant(s)

CHEN ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20,30-34,36,51-59 and 64-88 is/are pending in the application.
- 4a) Of the above claim(s) 30-34,36 and 74-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20,51-59,64-73 and 86-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's communication dated February 23, 2005. Election of claims 11-20, 51-59, 64-73 and 86-88 without traverse by the Applicant is acknowledged. Claims 11-20, 30-34, 36, 51-59 and 64-88 are pending in the application. Claims 30-34, 36 and 74-85 are withdrawn from consideration as being drawn to the non-elected group. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims. Elected claims 11-20, 51-59, 64-73 and 86-88 have been examined. The rejections are stated below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

3. Claims 11-20 and 86 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

Claims 11-20 and 86 are rejected under 35 U.S.C. § 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claims may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that

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includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to overcome the 101 rejection above, the following preamble is suggested for the independent claims 11 and 86: "A computer implemented method for automatically rebalancing ..." or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 13, 16-20, 55-59 and 64-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13 and 66 cite the limitation "steps of adjusting and re-storing the stored ratio between the first time and the second time" which is not clear to the Examiner. It is not clear as to what value for the "stored ratio" is finally stored. Claims 16-8, 55-57 and 69-71 cite the limitations "calculating a case for a probable replacement retirement income", "recalculating additional cases of human capital" and "displaying the results of the calculated cases to an investor". It is not clear what the Applicants mean by the phrases "calculating a case" and "recalculating additional cases". Claims 18, 57 and 71 cite the limitation "using the human capital calculated for the selected case" for which there is no antecedent basis. Claims 19, 58 and 72 cite the limitations "determining whether the first

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portfolio type should still be indicated for the investor given the recommendation of allocation of assets at the second time” and “or whether the investor should be shifted to an adjacent, second portfolio type” which are not clear. It is not clear what the Applicant means by “indicating the first portfolio type”, “investor should be shifted” and “an adjacent, second portfolio type”. Claims 20, 59 and 73 cite the limitation “shifting the investor to the second portfolio type” which is not clear. Claims 64-73 recite the term “system”. It is not clear if by the term “system” the Applicants mean “a method” or “an apparatus”. Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11, 12, 14, 15, 51-54, 64, 65, 67, 68 and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarbox et al (US Patent 2002/0169701).

With reference to claims 11, 51, 64 and 86-88, Tarbox teaches a method, a machine readable medium and a system for automatically rebalancing a portfolio of an investor, the method comprising the steps of: for a first time, determining a human capital of the investor (See Tarbox Paragraph 44); dividing the human capital of the investor into at least first and second investment types according to a predetermined formula, the first and second investment types having different degrees of risk (See Tarbox Paragraphs 44 and 45 and 66, formula determined by experts is interpreted to include a predetermined formula); summing a financial worth of the

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investor and the human capital to derive a total worth of the investor (See Tarbox Paragraph 44); making a target allocation of the total worth of the investor between the first and second investment types according to a predetermined, stored ratio (See Tarbox Paragraphs 44, 66 and 73, the election made by individuals is interpreted to include the stored ratio); for the first time, recommending an allocation of the assets of the financial worth of the investor between the first and second investment types such that the asset allocation of the total worth of the investor meets or most closely approaches the target allocation (See Tarbox Paragraphs 45 and 73); and for the first time, using the last said recommendation of allocation of assets to determine how assets in an investment portfolio of the investor ought to be allocated among predetermined investment vehicles (See Tarbox Paragraphs 66 and 73). A system and a machine-readable medium are inherent in the disclosure of Tarbox.

With reference to claims 12, 52 and 65, Tarbox teaches the steps of for a second time following the first time, recalculating the human capital of the investor; for the second time, recommending an allocation of the assets of the financial worth of the investor between the first and second investment types such that the asset allocation of the total worth of the investor most closely approaches the stored ratio; and for the second time, using the last said recommendation of allocation of assets to determine how assets in the investment portfolio of the investor ought to be allocated among predetermined investment vehicles (See Tarbox Paragraph 75, regular basis is interpreted to include a second time).

With reference to claims 14, 53 and 67, Tarbox teaches the step wherein the human capital is determined as a function of the investor's age (See Tarbox Paragraph 44).

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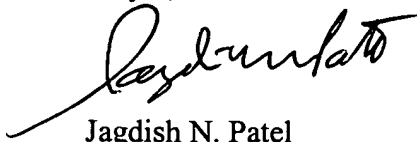
With reference to claims 15, 54 and 68, Tarbox teaches the step wherein the human capital is additionally determined as a function of the investor's mortality, income and savings rate (See Tarbox Paragraph 44).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax phone number for the Patent Office where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian
May 7, 2005



Jagdish N. Patel
Primary Examiner